

REMARKS

I. Status of Claims

Claims 1-56 are pending in this application. No claims have been amended by this Response.

II. Claim Rejections

A. U.S. Patent Publication No. 2002/0046431 to *Laurent et al.* in view of U.S. Patent No. 5,868,800 to *Cotteret et al.*

The Examiner has maintained the rejection of claims 1-56 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2002/0046431 to Laurent et al. ("*Laurent*")¹ in view of U.S. Patent No. 5,868,800 to Cotteret et al. ("*Cotteret*") for the reasons disclosed on pages 2-5 of the Final Office Action. Applicants respectfully traverse this rejection for reasons of record and the following additional reasons.

In this Final Office Action, the Examiner presents two new arguments to support his allegation of a prima facie case of obviousness. Each argument, however, falls short of establishing that the prior art suggests the desirability of combining the cited references to obtain the claimed invention. M.P.E.P. § 2142 ("The initial burden is on the Examiner to provide some suggestion of doing what the inventor has done."). Instead, the Examiner has merely established that each claimed ingredient is known in the art. This, however, is insufficient evidence to support a case of obviousness, as discussed in greater detail below.

¹ Applicants note for the record that Laurent issued as U.S. Patent No. 6,602,303 on August 5, 2003.

1. The Examiner's Reliance on Case Law is Misplaced

In rejecting the claims over *Laurent* in view of *Cotteret*, the Examiner's reliance on case law to establish a motivation to make the claimed invention from the teachings of the references is unwarranted. In the Final Office Action, the Examiner cites *In re Heck* for the proposition that a patent as a reference is "not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *Final Office Action*, page 2. In addition, the Examiner relies on *Merck & Co. v. Biocraft Laboratories*, for the proposition that "a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments." *Id.*, pages 2-3. While Applicants do not disagree with these general propositions, Applicants do disagree with the application of these holdings to the present facts.

Specifically, the Examiner relies on these holdings as a short-cut means for establishing a prima facie case of obviousness. This is improper. While it is true that a prior art reference may be relied on in its entirety, including disclosure of non-preferred embodiments, an examiner still must make **factual** findings of a motivation to combine teachings from the cited references to make the claimed invention. In other words, something, such as some reason or explanation, must be present in the prior art that demonstrates, to one of ordinary skill in the art, that the claimed invention would have been desirable, and that directs one of ordinary skill to make the claimed invention.

It appears that the Examiner does in fact believe that he has provided such a reason to support his allegation of motivation to combine. According to the Examiner, that reason is that *Cotteret* teaches the equivalence between oleic acid and lauric acid. *Final Office Action*, page 4. Specifically, as the Examiner understands it, when either of these ingredients is used in a dye composition the result is that hair is dyed in an intense shade. *Id.* Therefore, according to the Examiner, there is sufficient motivation to replace the oleic acid in *Laurent's* composition with the lauric acid in *Cotteret's* composition.

The Examiner's premise is incorrect. First, nothing in *Cotteret* suggests that oleic acid and lauric acid are interchangeable in the manner alleged by the Examiner. Further, *Cotteret* does **not** teach that oleic acid or lauric acid causes the intense shade. Rather, *Cotteret* teaches that all the benefits of its invention are derived from the use of a para-phenylenediamine substituted in position 2 and a 6-hydroxy-1,4-benzomorpholine compound. *Abstract*. In fact, in Example 1 of *Cotteret*, the inventors compared the inventive composition with an identical composition with the exception that the 6-hydroxy-1,4-benzomorpholine compound was replaced with resorcinol. Col. 5, lines 13-18. A significantly more intense shade was obtained for the inventive composition. Col. 5, lines 41-44. Thus, given that the presence of lauric acid in a dyeing composition could also result in hair that is not dyed an intense shade, depending on the other ingredients involved, no motivation would have existed for one to select this component, as the Examiner suggests.

Indeed, *Cotteret* provides not even the faintest suggestion as to *why* it would be desirable, when creating a dye composition, to isolate lauric acid and incorporate it into

a composition comprising (1) an oxidation dye and (2) at least one particular cationic poly(vinyl lactam) polymer. Indeed, it would have been equally plausible, based on *Cotteret's* disclosure, to select ethyl alcohol (another ingredient listed in the Examples). Simply put, using the Examiner's logic, *Cotteret's* disclosure could form the basis for any rejection based on *any* use of any cosmetic ingredient disclosed therein.

Applicants' own disclosure provides the only suggestion that the presently claimed combination provides at least some of the following advantages – “increased ease of mixing with at least one oxidizing agent and other optional components; improvement in foaming properties; and increased ease of elimination, for example, during rinsing.” Specification, para. [011]. Neither *Cotteret* nor *Laurent* even contemplate these particular problems. Thus, the presently claimed invention could not have been suggested by these references except by hindsight.

Moreover, although it is true that a disclosure can be relied on for all it teaches, this rule does have limits. A disclosure can only be relied on for what it *reasonably* teaches. Here, for instance, it is not reasonable to conclude that **any** combination of dye ingredients is suggested by the prior art. Indeed, it is a known rule that “combination claims can consist of combinations of old elements as well as new elements.” *Clearstream Wastewater Sys. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446, 54 USPQ2d 1185, 1189-90 (Fed. Cir. 2000).

To avoid violation of this rule, the M.P.E.P. requires the Examiner to provide factual support for an obviousness rejection. M.P.E.P. § 2142. In this case, besides the assertion that both lauric and oleic acid are included in compositions that provide intense color shades, the Examiner has made no findings as to why one skilled in the

art would have selected lauric acid, as opposed to any other dye component disclosed in the examples. Thus, for at least these additional reasons, the rejection should be withdrawn.

2. The Examples Demonstrate the Non-Obviousness of the Claimed Invention

In addition to providing insufficient support for his allegation of motivation to combine the cited references, the Examiner also improperly ignores persuasive evidence of non-obviousness presented by Applicants. In the Response dated March 10, 2005, Applicants contended that the Examples in the present specification illustrate that it would not have been obvious, as the Examiner contends, to substitute one fatty acid for another. Specifically, the Examples illustrate that the comparative composition, containing stearic acid (a fatty acid outside the scope of the presently claimed invention) was much less easy to prepare, less pleasant to apply, more difficult to remove, and resulted in inferior color quality. The Examiner dismisses this argument by contending that the comparative studies are not commensurate with the scope of the teaching of the prior art. *Final Office Action*, page 3. This is improper.

In particular, regardless of whether the prior art teaches or discloses stearic acid, the present Examples compare a composition that is identical to the claimed invention, with the exception of the replacement of lauric acid with stearic acid. The Example demonstrates that the type of fatty acid used has an effect on the final dye composition. *Cotteret*, as discussed above, does not suggest this. All it suggests is that oleic acid and lauric acid can be used in dye compositions. Thus, to dismiss the comparative Example merely because the prior art does not disclose stearic acid makes no sense.

Moreover, the Examiner contends that Applicants have not shown on record the criticality of the claimed composition over a composition that contains oleic acid. *Final Office Action*, page 2. Applicants submit that they are under no obligation to demonstrate the criticality of the claimed composition if the Examiner has not made out a case of prima facie obviousness. M.P.E.P. § 2142. In the present case, the Examiner has not done so. Accordingly, the burden has not shifted to the Applicants to demonstrate the nonobviousness of the claimed invention. Thus, for at least these reasons, Applicants respectfully request that the Examiner withdraw this improper rejection.

B. Rejection of Claims 16-17, 22, and 41-42

The Examiner maintains the rejection of claims 16-17, 22, and 41-42 over *Laurent* in view of *Cotteret* under 35 U.S.C. § 103. According to the Examiner, merely because these two references disclose the claimed dye components is sufficient motivation to a person of ordinary skill in the art to optimize the amounts of these components. *Final Office Action*, page 4. Applicants disagree.

A motivation to “optimize” particular dye components requires more than a mere mention in a document. Rather, the Examiner must make specific factual findings as to why it would have been obvious to optimize these components. M.P.E.P. § 2142. Indeed, the M.P.E.P. makes clear that “[c]onclusory statements of . . . motivation, without any articulated rationale or evidentiary support, do not constitute factual findings. M.P.E.P. § 2144.08(II). Thus, before the Examiner can conclude that it would have been obvious to optimize the presently claimed amounts for the cationic poly(vinylactam) (claims 16 and 17), fatty acids (claim 22), and surfactants (claims 41

and 42), he must provide factual evidence as to why one skilled in the art would have been motivated to do so. Since the Examiner has not done so here, the rejection is improper and should be withdrawn.

C. Rejection of Claims 55-56

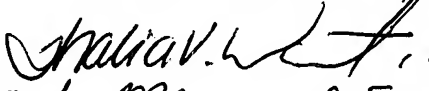
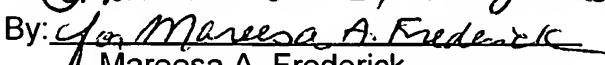
Finally, with respect to the multi-compartment kit claim rejections, the Examiner again asserts that it would have been obvious to make the claimed kits because *Laurent* teaches a device or kit for dyeing hair comprising at least two compartments. *Final Office Action*, page 4. Applicants maintain that regardless of whether it would have been obvious to make the claimed kits, the Examiner has not shown that it would have been obvious to make the claimed composition of claims 55-56 for the reasons discussed above. Accordingly, for at least this reason, the rejection is improper and should be withdrawn.

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

 Reg. No. 39,064
By: 
Mareesa A. Frederick
Reg. No. 55,190

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